

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKINORI TOKINAGA and ATSUHIKO OMO

Appeal No. 2004-0739
Application No. 09/937,408

ON BRIEF

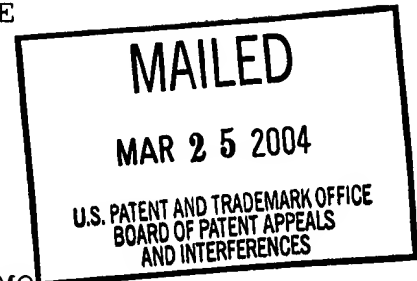
Before KIMLIN, GARRIS and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner because the case is not ripe for a decision on appeal.

All of the claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tanaka.¹ Claim 5, which is the sole independent claim, claims an instrument panel supporting member

¹ Tanaka et al., U.S. 5,238,286, issued August 24, 1993.



structure having "a main body constituted by a pipe, the pipe arranged in a lateral direction and having ends connected to right and left front pillars ... wherein the pipe constituting the main body is integrally formed with joining parts by crush-molding, the joining parts joined to the front pillars."

The appellants' specification does not define "crush-molding", and the record does not indicate that "crush-molding" was a known term of art. Thus, the meaning of "integrally formed with joining parts by crush-molding" in claim 5 is not clear. Also, the examiner and the appellants have not addressed the meaning of "integrally formed", taking into account the disclosure in the specification that the main body and the pillars can be joined by bolts (page 6).

Moreover, the specification states that "since the connecting parts are formed as integral parts of the pipe that forms the main body as a result of crush-molding being performed on both ends of the pipe, the side brackets connected to the both ends of the main body in conventional supporting members become unnecessary" (page 4). Claim 5, however, recites that "the main body is integrally formed with joining parts by crush-molding,

the joining parts joined to the front pillars." Thus, it is not clear whether the "joining parts" to which the body is integrally formed and which are joined to the front pillars can be side brackets.

Furthermore, the examiner argues that "crush-molding" in claim 5 is a product-by-process limitation, and that the patentability of the claimed product does not depend on its method of production (answer, page 5). The examiner, therefore, does not give weight to this limitation. The examiner has the initial burden of establishing a *prima facie* case of unpatentability by providing evidence or reasoning which indicates that the appellants' claimed product and that of the prior art are identical or substantially identical. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). Only after such evidence or reasoning has been provided does the burden shift to the appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of the appellants' claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *Best*, 562 F.2d at 1255, 195 USPQ at

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433-434; *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). The examiner has not provided the required evidence or reasoning which indicates that the appellants' claimed product made using crush molding and Tanaka's product are identical or substantially identical.

We therefore remand the application to the examiner for the examiner and the appellants to clarify on the record the meanings of the above-discussed claim terms and for the examiner to provide the required evidence or reasoning which indicates that the appellants' claimed product made using crush-molding and Tanaka's product are identical or substantially identical.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

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If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

REMANDED

Edward C. Kimlin

EDWARD C. KIMLIN)
Administrative Patent Judge)

Bradley R. Garriss

BRADLEY R. GARRIS)
Administrative Patent Judge)

) BOARD OF PATENT
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